

## **REMARKS**

### **I. Status of the Claims**

Claims 1-29 were originally filed and subsequently replaced with claims 1-31. Claims 28 and 29 have been canceled, whereas claims 32 and 33 have been added. Upon entry of the present amendment, non-elected claim 31 is canceled. Claims 1-27, 32, and 33 are currently pending under examination. The Examiner has indicated claims 2-7 as allowable in the June 23, 2004, Office Action.

Upon entry of the present amendment, claims 1, 8, 12, 21, 26, 30, and 33 are amended to recite "functions" in place of "is capable of functioning (acting)." The word "wherein" is added in claim 12 to ensure proper grammar. Claim 27 is amended to ensure proper antecedent basis.

The present amendment adds no new matter.

### **II. Amendment to the Specification**

The specification is amended to include the information that this application is the national phase of PCT/US99/11082.

### **III. Objections to the Claims**

The Examiner objected to claim 27 for referring to itself. This informality has been corrected by the present amendment.

### **IV. Claim Rejections**

#### **A. 35 U.S.C. §112 Second Paragraph**

Claims 1, 8-27, 32, and 33 were rejected under 35 U.S.C. §112 second paragraph for allegedly failing to point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner asserted that the term "capable of" in claims 1, 8, 12, 21, 26, 30, and 33 renders the claims unclear as to whether the claimed compound has to have the specified activity. As amended, claims 1, 8, 12, 21, 26, 30, and 33 recite "functions"

instead of "capable of functioning" or "capable of acting." Applicants submit that this rejection is overcome.

B. 35 U.S.C. §102

The rejection of claim 1 under 35 U.S.C. §102(a) for alleged anticipation by GenBank Accession No. C80740 or C80177 was maintained. The Examiner indicated that the declaration under 37 C.F.R. §1.131 accompanying Applicants' last response was ineffective because it did not have both inventors' signatures.

Applicants' records indicate that the declaration as submitted on March 22, 2004, indeed bore signatures of both Dr. Pavlakis and Dr. Nappi. To expedite prosecution, this declaration is resubmitted along with this response. Applicants submit that the declaration and attached evidence establish the present inventors' possession of SEQ ID NO:1 prior to October 20, 1997, the earliest entry date for GenBank Accession Nos. C80740 and C80177. Therefore, these two GenBank entries are not available as §102(a) references against the pending claims in the present application. Applicants respectfully request the withdrawal of the anticipation rejection.

Appl. No. 09/673,716  
Amdt. dated September 20, 2004  
Reply to Office Action of June 23, 2004

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**CONCLUSION**

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 415-576-0200.

Respectfully submitted,



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